

REMARKS

Claims 1-21 are rejected under 35 U.S.C. §102(e)(2) as being anticipated by *Bourke-Dunphy et al.* (U.S. 6,449,642). This rejection is respectfully traversed for the reasons set forth below.

Independent claims 1, 8 and 15 include: ... storing the unique computer name record for the information handling system in a memory of the information handling system; transferring the unique computer name record to a name registry of the information handling system; booting the information handling system from the substantially similar boot program used by each of the plurality of information handling systems; reading the name registry; and broadcasting the unique computer name record on the network to check for conflicts, and whereby if no conflict exists, the information handling system is recognized as a valid node on the network.

The PTO provides in MPEP § 2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the *Bourke-Dunphy et al.* patent must contain all of the claimed elements of independent claims 1, 8 and 15. However, the *Bourke-Dunphy et al.* patent does not include the claimed combination. Therefore, the rejection is unsupported by the art and should be withdrawn.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." "The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Furthermore, Applicants traverse this rejection on the grounds that the reference is defective in establishing a *prima facie* case of obviousness for the reasons stated above.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

The Federal Circuit has held that a reference did not render the claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), because inter alia, the examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness *vel non* of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

In the present case, the reference fails to teach all the limitations of the claimed invention. Thus, the rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, 35 USC §103 provides that:


A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Because all the limitations of claims 1, 8 and 15 have not been met by the *Bourke-Dunphy et al.* patent, it is impossible to render the subject matter as a whole obvious. Thus the explicit terms of the statute have not been met and the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

In view of the above, it is respectfully submitted that claims 1-4, 6, 8-11, 13, 15-18 and 20 are in condition for allowance. Accordingly, an early Notice of Allowance for the remaining claims is courteously solicited.


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Respectfully submitted,


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